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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,837	12/11/2003	Herman Rodriguez	AUS920030906US1(4028)	2209
45557 7590 07/28/2010 IBM CORPORATION (ISS) C/O SCHUBERT LAW GROUP PLLC 6013 CANNON MOUNTAIN DRIVE, S14 AUSTIN, TX 78749				
EXAMINER				
OYEBISI, OJO O				
ART UNIT		PAPER NUMBER		
3695				
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07/28/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/733,837

Applicant(s)

RODRIGUEZ ET AL.

Examiner

OJO O. OYEBISI

Art Unit

3695

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Interval Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

In the amendment filed on 05/18/10, the following have occurred: claims 1, 6, 9, 17 and 23 have been amended, and claims 1-29, 31 are currently pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (Jones hereinafter, US PAT NO.: 7,349,566) in view of Park et al (Park hereinafter, US PUB NO.: 2003/0225705).

Re claims 1, 2-29 and 31. Jones discloses a method for generating an e-check, the method comprising: scanning a check to create an image of the check in response to receiving a check as payment for a transaction (see col.8 line 60-col.9 line 65); entering an amount of currency represented by the check into a point of sale terminal (i.e., amount and payee, see col.10 line 59-60), identifying check information that describes a

bank and a bank account, wherein the check comprises the check information (see col.16 lines 6-10). Jones does not explicitly disclose generating a negotiable instrument, wherein the negotiable instrument comprises the e-check based upon the image, the amount, and the check information, wherein further the e-check includes the image, wherein further the e-check is in an electronic format capable of being transferred electronically. However, Park discloses generating a negotiable instrument, wherein the negotiable instrument comprises the e-check based upon the image, the amount, and the check information, wherein further the e-check includes the image, wherein further the e-check is in an electronic format capable of being transferred electronically (see the abstract, also paras 0015). Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of generating a negotiable instrument as taught by Park in the system of Jones, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

Applicant's arguments filed 05/18/2010 fully considered but they are not persuasive. The applicant argues in substance that the prior arts of record fail to disclose "generating a negotiable instrument, wherein the negotiable instrument comprises the e-check based upon the image, the amount, and the check information; wherein further the e-check includes the image, wherein further the e-check is in an electronic format capable of being transferred electronically." Contrary to the applicant's

assertion, Park discloses generating a negotiable instrument image file, the image file comprising: i) a recognizable alpha numeric representation of the payee name within a payee field; ii) a recognizable numeric representation of the payment amount within a numerical amount field; iii) a recognizable alpha numeric representation of the payment amount within an alpha numeric amount field; iv) a MICR representation of a routing number and an account number within a first MICR zone across the bottom of the negotiable instrument; and v) a MICR representation of the numeric sequence within a second MICR zone across the top of the negotiable instrument. The examiner contends that a negotiable instrument image file, as taught by Park, is akin to the e-check image as taught by the applicant.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on (571)272-8594. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OJO O OYEBISI/
Primary Examiner, Art Unit 3695